modulator/blocker that is a mannosylated molecule, classified in class 435, subclass 7.2.

Group IV: Claims 1, 2, 9-12, 24-28 and 31, allegedly drawn to a method of preventing or treating a disease using a DC-SIGN modulator/blocker that is a recombinantly produced protein, classified in class 435, subclass 7.2.

Group V: Claims 43-46, allegedly drawn to a method of preventing or treating inflammation using a DC-SIGN modulator/blocker, classified in class 435, subclass 7.2.

Group VI: Claims 47-49 and 65, allegedly drawn to a DC-SIGN modulator/blocker that is a derivative of an effector molecule, classified in class 424, subclass 218.1.

Group VII: Claims 47-48, 50-58, 65 and 74-80, allegedly drawn to a DC-SIGN modulator/blocker that is an antibody, classified in class 424, subclass 147.1.

Group VIII: Claims 59-64, allegedly drawn to a method of identifying a DC-SIGN modulator/blocker, classified in class 435, subclass 4.

Group IX: Claims 66-73, allegedly drawn to a method of targeting a subject molecule to a cell expressing a DC-SIGN receptor, classified in class 435, subclass 4.

Additionally, the Examiner required further restriction from claims 39 and 40 if Group I or II is elected. Specifically, the Examiner stated that Applicants must elect either Ebola, HIV or SIV.

In response to the restriction requirement, Applicants provisionally elect to prosecute Group I, claims 1-3, 9-12, 24-28, 39-40 and 42, *with traverse*. Applicants also elect HIV, *with traverse*.

Traversal of Restriction Requirement

Applicants traverse the restriction requirement between Groups I-IV on the ground that the Office has improperly limited the scope of the claims by requiring restriction between Groups I-IV. Specifically, in issuing the restriction requirement, the

Office has, without Applicants' permission or approval, limited the scope of claims 1, 2, 9, 10, 39, and 40 to certain species claimed in dependent claims. Specifically, the only subject matter distinctions provided by the Office as a basis for distinguishing Groups I-IV is that the modulator/blocker of Group I is a derivative of an effector molecule, the modulator/blocker of Group II is an antibody, the modulator/blocker of Group III is a mannosylated molecule, and the modulator/blocker of Group IV is a recombinantly-produced protein. However, claims 1, 2, 9, 10, 39, and 40 do not specifically recite any of these species of modulator/blocker. Instead, claims 1, 9, and 39 recite "a DC-SIGN modulator" and claims 2, 10, and 40 recite "a DC-SIGN blocker".

Applicants respectfully submit that they have a statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter they regard as their invention as they choose. Issuing a Restriction Requirement by incorporating an unclaimed limitation into claims 1, 2, 9, 10, 39, and 40 in an effort to limit the claims to certain disclosed embodiments, with the idea that Applicants would have to carve up those claims and pursue the non-elected subject matter in a separate application, violates this right under § 112. Indeed, the C.C.P.A. has characterized such an action by the Office as tantamount to a refusal to examine. *See In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978).

In addition, the Restriction Requirement makes it impossible for Applicants to obtain the full scope of their invention, even if each of Groups I-IV were to be pursued in all four divisional applications that would be required as a result of the restriction requirement. That is, even if Applicants pursued each and every Group set forth in the restriction requirement, they still would not obtain full coverage for claims 1, 2, 9, 10, 39,

and 40, which generically recite "a DC-SIGN modulator" or "a DC-SIGN blocker". Thus, the restriction requirement is improper. For this reason, Applicants respectfully request withdrawal of the restriction requirement and examination of claims 1-42 (corresponding to Groups I-IV) together in the instant application.

Applicants are unsure whether the Office intended to require restriction between Ebola, HIV, and SIV only in claims 39-42, which recite "Ebola, HIV or SIV", or in all of claims 1-42. Applicants note that none of claims 1-38 recites "Ebola, HIV or SIV". Thus, to the extent that the Office intended that this requirement apply to claims 1-38, Applicants respectfully submit that such a requirement is an impermissible attempt by the Office to foreclose Applicants from exercising their statutory right to obtain claims to that which they regard as their invention, as described above regarding the requirement of restriction between Groups I-IV. For this reason, Applicants submit that the requirement to elect Ebola, HIV or SIV should not apply to claims 1-38.

Regarding claims 39-42, Applicants submit that the Office has not shown that a serious burden exists in examining these claims as they recite Ebola, together with these claims as they recite HIV, together with these claims as they recite SIV. For this reason the requirement of restriction is improper. *See* M.P.E.P. § 803 (stating that restriction is only appropriate if inventions are independent or distinct, **and** not requiring restriction would place a serious burden on the Examiner). Here, Applicants submit that the Office has not shown that any serious burden exists.

The M.P.E.P. provides that an Examiner may establish the existence of a serious burden if claims to distinct inventions were to be examined together by showing that the claimed subject matter is separately classified, that the claimed subject matter has

attained a separate status in the art even though classifiable together, or that searching the claimed subject matter would require searching in different fields. M.P.E.P. § 808.02. Applicants submit that the Examiner has not demonstrated that any of these requirements is met and that, therefore, restriction between Ebola, HIV, and SIV is improper. *See* M.P.E.P. § 803.

Specifically, regarding classification, the Office has not indicated that claims reciting Ebola, HIV, and SIV would be classified differently from each other. Rather, the Office merely has stated that "preventative and treatment methods are divergent for these viruses." Applicants respectfully submit that they are unsure what the Office is conveying by this statement, but in any event that the statement does not provide "appropriate explanation" that Ebola, HIV, and SIV have formed a separate status in the art as required by M.P.E.P. § 808.02. Applicants also note that the Office's statement regarding divergence is clearly not correct; indeed, Applicants' own claims recite a single method of prevention and treatment for all of these viruses.

Finally, the Office has also not shown that searching different fields is required to conduct a thorough search of claims 39-42 as they recite Ebola, claims 39-42 as they recite HIV, and claims 39-42 as they recite SIV. In this regard, Applicants note that to make such a showing the Office must show that "it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists." M.P.E.P. 808.02. Applicants submit that the Office has not shown that any of Ebola, HIV or SIV must be searched in a place where no pertinent art for the remaining two viruses exists. For these reasons Applicants submit that the Office has not demonstrated a serious burden and that, therefore, examination of claims 39-42 as they recite Ebola, together

with claims 39-42 as they recite HIV, together with claims 39-42 as they recite SIV in this application is appropriate.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: September 15, 2004

By: Salvatore J. Arrigo Reg No. 46,063
for: Kenneth J. Meyers
Reg. No. 25,146